

## **REMARKS**

Upon entry of the present amendment, all of previously pending claims 1-17 will have been canceled without prejudice or disclaimer of the subject matter. Additionally, claims 18-34 will have been submitted for consideration by the Examiner. The cancellation of the above-noted claims and the submission of new claims will have been made in order to define the features of Applicant's invention with enhanced clarity. However, such cancellation will not have been made in view of the prior art and has not been made with an intent to narrow the scope of the pending claims. Accordingly, no prosecution history estoppel should attach to the above noted claim amendments.

Initially, Applicant notes with appreciation the Examiner's acknowledgment of his claim for foreign priority under 35 USC 119, as well as for his confirmation of the receipt of the certified copies of the foreign priority documents, upon which the above noted claim for foreign priority is based. Since the present application is a national stage application, it is assumed that the certified copies were received from the International Bureau.

Additionally, Applicant notes that the Examiner has not objected to the drawings filed in the present application. However, in order to complete and clarify the record of the present application, Applicant respectfully requests that the Examiner explicitly indicate his acceptance of the drawings filed the present application.

In the outstanding official action, the Examiner objected to the specification. In particular, the Examiner required a reference to the prior application to be inserted as the first sentence of the specification of this application. In the alternative, the Examiner required submission of an application data sheet if Applicant intends to rely on the filing date of the prior application. It is respectfully submitted that the Examiner's requirement is in error.

In this regard, Applicant notes that the present application is a national stage of PCT/JP 04/09052 that was filed on June 21, 2004 in accordance with the provisions of 35 USC 371. Accordingly, none of the cited portions of the Code of Federal Regulations or of the United States Code apply to the present application. In other words, the present application does not rely on the above identified international application but rather is a national stage thereof.

Further, not only is a reference to the prior application in the first sentence of the specification not required, but to do so is explicitly indicated to be incorrect. In this regard, Applicant respectfully directs the Examiner's attention to MPEP section 1893.03(d). In particular, the MPEP notes that a national stage application submitted under 35 USC 371 (i.e. the present application) may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the international filing date of the international application. In other words, since the international application is not an earlier replication (i.e. it has the same filing date as the national stage), a benefit claim under 35 USC 120 in the national stage, to the international application, is inappropriate and may result in the submission being treated as an application filed under 35 USC 111(a).

Additionally, the MPEP explicitly indicates that "it is not necessary for the Applicant to amend the first sentence(s) of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage".

In view of the above, Applicant respectfully requests that the Examiner reconsider and withdraw the above-noted requirement and explicitly indicates that no such amendment of the first sentence of the specification is required in the present application.

In the outstanding official action, the Examiner asserted that the Information Disclosure

Statement filed in the present application on March 24, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP section 609. In particular, the Examiner asserted that the Information Disclosure Statement does not include "a concise explanation of the relevance, as it is presently understood.... of each patent listed that is not in the English language". It is respectfully submitted that the Examiner is incorrect and that each of the documents cited in the Information Disclosure Statement was filed in full compliance with 37 CFR 1.97 and 1.98 and thus should be considered.

Initially, Applicant wishes to correct the record by noting that no Information Disclosure Statement was filed the present application on March 24, 2005. Rather, the Information Disclosure Statement to which the Examiner made reference was filed on March 24, 2006.

Further, each of these foreign-language documents that the Examiner crossed out and refused to consider was cited in an International Search Report that issued in International Application PCT/JP 2004/009052. Such citation comprises the concise explanation of relevance as explicitly indicated at the top of page 3 of the above noted Information Disclosure Statement. In this regard, Applicant notes that a copy of the International Search Report was attached to the above noted Information Disclosure Statement and explicitly identified the relevant passages of each of the above noted documents. In this regard, the Examiner's attention is respectfully directed to MPEP section 609.04(a)III.

Furthermore, with respect to Japanese laid open publication number 2002-157516, which the Examiner also crossed out, the Information Disclosure Statement explicitly indicated that this document was cited on page 2 of the specification of the present application.

Accordingly, as an appropriate and concise explanation of relevance was indicated for each of the non-English language documents cited in the above noted Information Disclosure

Statement, Applicant respectfully requests that the Examiner explicitly indicate his consideration of these documents by forwarding to Applicant, with the next communication in the present application, an appropriately annotated copy of the PTO 1449 form that was attached to the above noted Information Disclosure Statement.

Additionally, in the official action, the Examiner further asserted that the numbers of the US patent documentation appear to be incorrect. It is respectfully submitted that the Examiner is clearly in error. The document numbers are not incorrect, but leading zeros have been eliminated therefrom so as to be more fully consistent with the document citation format utilized in the International Search Report.

Accordingly, for each of the above-noted reasons, it is respectfully submitted that each of the documents cited in the Information Disclosure Statement was cited in full compliance with the appropriate regulations and consideration thereof, together with explicit confirmation of such consideration, is respectfully requested in due course.

In the outstanding official action, the Examiner objected to claims 3 and 4, asserting that a term utilized therein is unclear. By the present response, claims 3 and 4 have been canceled without prejudice or disclaimer of the subject matter thereof. In the newly submitted claims, the objected term has not been used and it is submitted that all of the language utilized in the presently pending claims is clear and consistent.

In the outstanding official action, the Examiner rejected claim 16 and 17 based upon 35 USC 101. In this regard, the Examiner asserted that the claimed invention is directed to non-statutory subject matter.

At least because claims 16 and 17 have now been canceled, it is respectfully submitted that the above noted rejection has been rendered moot. Additionally, Applicant respectfully

submits that all of the newly submitted claims are directed to clearly statutory subject matter.

In the outstanding official action, the Examiner rejected all of the previously pending claims under 35 USC 112, second paragraph as being indefinite for failing to particularly and distinctly claim subject matter which Applicant regards as the invention. As previously noted, by the present response, all of the previously pending claims have been canceled and accordingly at least for this reason the above noted rejection, which is directed to the language of the claims, has been rendered moot. Additionally, each of the newly submitted claims recites the features of Applicant's invention with clarity and particularity. Further, the claims distinctly claim the subject matter which Applicant regards as the invention. Accordingly, reconsideration and withdrawal of the outstanding rejection of any of the claims under 35 USC 112, second paragraph is respectfully requested and is now believed to be appropriate and proper.

In the outstanding official action, the Examiner rejected claims 1-17 under 35 USC 103(a) as being unpatentable over Ginter (U.S. Patent No. 5, 892, 900) in view of Fuller (U.S. Patent No. 6, 216, 112.). Applicant respectfully traverses the above noted rejection and submits that it is inappropriate with respect to the claims in the present application. Accordingly, Applicant respectfully request reconsideration and withdrawal of the outstanding rejection, together with an indication of the allowability of all of the claims pending in the present application, in due course.

In particular, Applicant respectfully submits that the disclosures of the references relied upon by the Examiner, even if combined in the manner proposed by the Examiner, are inadequate and insufficient to teach, disclose, suggest, or even to render obvious the claimed combinations of features recited in the claims.

The present invention relates to a viewing control apparatus, a viewing control method,

and a viewing control system. Utilizing the viewing control apparatus as defined by the recitations of claim 18 as a nonlimiting example of the invention disclosed in the present application, the viewing control apparatus acquires, by broadcast, communication, or from a recording medium, contents encrypted by first key data, contract information including identification information of the contents and date information indicating a date which allows viewing of the contents, an advertisement associated with the contract information, and common information including the first key data and the identification information. The viewing control apparatus includes a storage that stores the contract information associated with the advertisement upon the advertisement being viewed. An extractor, upon the common information being acquired, searches the identification information included in the contract information stored in the storage, for a same identification information as the identification information included in the acquired common information, determines whether or not the viewing of the contents associated with the searched identification information is allowed, based on the date information included in the contract information including the searched identification information, and, upon determination that the viewing is allowed, extracts the first key data from the acquired common information. A decoder decodes the encrypted contents using the extracted first key data.

The present invention relates to a viewing control apparatus that enables the distribution of content (e.g. software) where advertisements are incorporated into the distributed content and compensation for the source of the content is based on revenues related to the viewing of the advertisement. In other words, by viewing the advertisement prior to viewing the content (e.g. utilizing the software) the source (e.g. author or owner) of the content can be compensated by the source of the advertisement and the user is enabled to utilize the content without payment (or for

a reduced payment). According to the features of the present invention, it is ensured that the viewer or user actually views the advertisement, and, since an expiration date for viewing of the content, based upon the viewing of the advertisement is set, the advertiser can be sure that the latest version of an advertisement is viewed by the viewer or user. In other words, the expectations of the advertiser that a viewer views the current advertisement, not an outdated or stale version of the advertisement can be fulfilled.

According to a recited feature of the present invention, encrypted content, contract information (which includes identification information of the contents and date information), an advertisement associated with the contract information, and common information (which includes first key data and identification information of the contents) are acquired. Upon viewing of the advertisement, the contract information associated with the advertisement is stored. It is determined whether or not viewing of the content is permitted based upon the stored contract information and the acquired common information. Thus, upon a determination that viewing is permitted, first key data is extracted and the extracted first key data is utilized to decode the encrypted content. No proper combination of the Ginter and Fuller references relied upon by the Examiner disclose at least these aspects of the present invention, in the claimed combinations.

As a result of these recited features of the present invention, and as noted above, the present invention provides the benefit of permitting content to be viewed when an advertisement has been viewed and accordingly the viewer can view the contents (e.g. utilize a software product) free of charge while the advertiser can be certain that a current version of the advertisement has been viewed by the user. As a result of these features, the expectations of the source of the advertisement are fulfilled and the producer of the content can be compensated

based upon content produced in the past. In this regard, the Examiner's attention is respectfully directed, particularly but not exclusively, to paragraphs [0229] and [0232] of U.S. Patent Application Publication 2007/0098165.

These features are not disclosed nor rendered obvious by any proper combination of Ginter and Fuller relied upon by the Examiner. In setting forth the rejection, the Examiner admits that Ginter does not contain any disclosure relating to an advertisement associated with contract information. Thus, no contract information can be stored upon the advertisement being viewed. Inherently then, Ginter also cannot disclose an extractor that searches the identification information included in the contract information and certainly cannot determine whether or not viewing of the content associated with the searched identification information is allowed, based on the date information included in the contract information, as these terms are explicitly defined in the pending claims.

Although Fuller, according to the Examiner, discloses the offering of electronic content wherein the advertisements are displayed before the content can be used, Fuller nevertheless does not disclose or teach the acquiring the particularly defined items encrypted (content, contract information, an advertisement, and common information) recited in Applicant's claim. Yet further, neither Ginter nor Fuller disclose storing the contract information associated with the advertisement upon the advertisement being viewed, determining whether or not viewing of the content is allowed, and decoding the encrypted content using the extracted first key data as explicitly recited in the presently pending claims. Thus, no proper combination of the relied upon references contain disclosures that are adequate to render the pending claims unpatentable.

Moreover, merely because Fuller and Ginter are both "related to content distribution," provides no logical reasoning for combining the teachings thereof as proposed by the Examiner.



While Fuller may well have been aware of the problem which the present invention solves, the disclosure of Fuller clearly does not solve this problem and certainly not in a manner recited in Applicant's clients.

According to additional aspects of the present invention, claim 21 defines a structure that allows or permits viewing of the contents when an associated advertisement is viewed from beginning to end. Yet further, claim 23 defines a viewing control apparatus which ensures not only that the beginning and end of an associated advertisement are viewed but also identifies points of the advertisement between the beginning and end, and verifies, by reference to time intervals, that the advertisement is viewed without fast forwarding. These additional features of Applicant's invention are also not disclosed by any proper combination of Ginter and Fuller.

In addressing various of the claimed recitations (of the previously pending claims), the Examiner took the position that certain recitations are non-functional descriptive material and thus assigned no patentable weight thereto. It is respectfully submitted that the Examiner is in error as the expiration date is clearly functional and is utilized as a basis for a determination whether contents can be viewed or not viewed. Similarly, the other recitations, which the Examiner asserts are non-functional descriptive material are in fact explicitly recited features and aspects of the present invention and thus must be given patentable weight.

Moreover, the Examiner's comments regarding the term "when" are noted and are submitted to be incorrect. Nevertheless, in order to resolve any issues the Examiner may have this term, it has been deleted from the pending claims.

Accordingly, Applicant respectfully submits all of the claims in the present application are clearly in condition for allowance and an action to such effect is respectfully requested, in

due course. Such action is now believed to be appropriate and proper and is thus earnestly requested.

## **SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application into condition for allowance and believes that he has now done so. Applicant has addressed the Examiner's objection to the specification and has shown the same to be inappropriate and improper. Applicant has additionally addressed the Examiner's refusal to consider the documents cited in the Information Disclosure Statement and has also shown the same to be inappropriate.

Applicant has additionally submitted a new set of claims that are in full compliance with 35 USC 101 as well as with 35 USC 112, second paragraph.

Applicant has further addressed the prior art rejection asserted against the claims and has shown the same to be inappropriate. Applicant has discussed the disclosure of the references and has pointed out the shortcomings and deficiencies thereof both individually as well as in the proposed combination. Further, Applicant has discussed the explicitly recited features of the presently pending claims, and with respect thereto, has pointed out the deficiencies of the references relied upon by the Examiner. Accordingly, Applicant has provided a clear and convincing evidentiary basis supporting dependability of all of the claims the present application and respectfully requests an indication to such effect in due course.

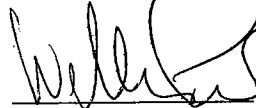
Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby

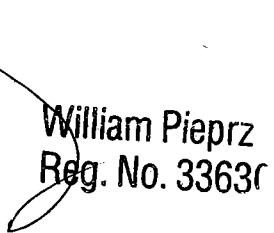
authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,  
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